

REMARKS

Applicants note with appreciation the Examiner's assistance in the telephone interview of April 20, 2006 regarding alternatives for overcoming the §112 rejections.

Claims 1, 4, 5 and 9 are currently pending.

Rejections under 35 U.S.C. §§132/112

The specification stands rejected under 35 U.S.C. §132 as containing new matter. Applicants have amended the specification to remove the language added in the previous responses. Accordingly, the specification now reflects the application as originally filed and contains no new matter. Withdrawal of this rejection is respectfully requested.

Claims 1, 4-5 and 9 stand rejected under 35 U.S.C. §112, first paragraph, as containing new matter.

Claim 1 is amended to remove language added in the previous responses said to constitute new matter. Claim 1 is also amended to indicate that 90% by weight of the particles of the dispersion are less than 40 nm in size (not 90% of the particles in absolute number of particles). No new matter is added by this amendment; the words "by weight" were inadvertently omitted from the original disclosure, and were an obvious error that is now corrected. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. MPEP 2163.07, *In re Odd*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Such is the error in the current situation. As is well known to one skilled in the art, separation of particulate materials by the ultracentrifugation method is based on the weight of the particle. Thus, one skilled in the art would immediately recognize, upon reading the specification and claims, that the units for particle size were incorrectly reported and that units in weight percent were intended. Enclosed are two web articles which describe in detail the theoretical basis for determining the weight of particles/macromolecules based on sedimentation diffusion. One is a publication of the University of Sydney entitled "Rotation" found at http://www.physics.usyd.edu.au/super/life_sciences/FE/FE6.pdf which describes at

page 69 how the ultracentrifuge is used to measure the molecular weight of particles. The second is a publication of Beckman Coulter <http://www.beckman.com/resourcecenter/labresources/sia/ds820.asp> entitled "Determination of Molecular Weights by Sedimentation Equilibrium" which also describes determination of molecular weight of macromolecules using ultracentrifugation methods. It is well-known that ultracentrifugation separates particles or molecules on the basis of weight and size.

Moreover, the specification contains a citation (at page 4, lines 1 – 4) to a journal article which describes a method of determining particle size by ultracentrifugation, and which reports the units of measurement in weight percent. This method was followed by Applicants. A copy of this article was previously provided to the USPTO. Applicants have stated under oath, both with the filing of the application and the declaration filed January 19, 2006, that ultracentrifugation was the method by which particle size was determined. Clearly, the omission of the correct units was an obvious error and an amendment to correct this omission does not constitute new matter. Applicants respectfully submit that Claims 1, 4, 5 and 9 meet all requirements under §112 of the statute.


Applicants note with appreciation withdrawal of the prior art rejections. The claims as currently written are novel and nonobvious in view of the references previously cited, Louwet et al., U.S. 6,632,472, Jonas et al., U.S. 6,391,481 and Krafft et al, U.S. 5,370,981. None of the cited references disclose dispersions wherein at least 90% by weight of the particles are less than 40 nm in size. As shown in the comparative data provided in the application at page 12, dispersions of the present invention provided at least an 8-fold increase in resistivity as compared to dispersions where the particle size was 50 – 100 nm. This result was unexpected, and could not have been predicted based on the teachings of any of the cited references, alone or in combination.

SUMMARY

As all outstanding issues have been addressed, Applicants respectfully submit Claims 1, 4, 5 and 9 are in condition for allowance; such action is respectfully requested at an early date.

Respectfully submitted,

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